REMARKS

The Examiner provides a number of objections and rejections. We list them here in the order in which they are addressed.

I. Claims 1, 9 and 11-12 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Little *et al.* (U.S. Patent No. 6,207,370) in view of Garvin *et al.* (U.S. Patent No. 6,329,180) and further in view of Knop *et al.*

II. Claims 1, 9 and 11-13 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Little *et al.* (U.S. Patent No. 6,207,370) in view of Garvin *et al.* (U.S. Patent No. 6,329,180) further in view of Knop *et al.* and Elion *et al.*

Applicants respond as follows:

I. Claims 1, 9 and 11-12 are not unpatentable under 35 U.S.C. §103(a).

In piecing together the present rejection the Examiner admits the following deficiencies of the cited references:

> "Little et al do not explicitly teach this method wherein the first and second epitope markers are different and wherein the second epitope marker is selected from the group consisting of SEQ ID NOS: 6-9, nor do they teach use of two epitope makers for the first primer."[1]

And,

> "However, Garvin et al. do not teach two epitope markers for the first primer."[2]

While the Applicants disagree with the Examiner's analysis of the teaching(s) of these references, as well as the propriety of their combination, it is clear that both references recite the same deficiency. That is, they both fail to teach a primer with two epitope markers. Moreover, inherent to this admitted deficiency is the additional FACT that neither of these references describes the use of more than two (i.e. three) epitope markers in a set of primers.

The Examiner attempts to remedy this situation using Knop *et al.* – a reference that

[1] Office Action, page 4, lines 11-14.
[2] Office Action, page 5, lines 14-15.

discloses two or more epitope markers on the **same** primer (first primer). Even assuming momentarily that this combination is appropriate, ***none of these references discusses a third epitope marke***r. And yet, the Examiner selects primers from each reference as if they were intended to be used together in order to recreate the Applicants' invention. This is the absolute definition of an impermissible hindsight-driven combination of references! What additional function does the third epitope marker serve since the references already allow a "two-step purification process"?[3] The Examiner does not say. Indeed, the Examiner's reasoning fails to deal with the third epitope question:

> "One of ordinary skill in the art would have been motivated to combine the teachings of Little et al with those of Garvin et al and Knop et al because Garvin et al and Knop et al teach that the use of a second tag, different from the first, would allow for a two step purification process that could distinguish between full length protein products and those which were truncated and/or those which were the product of internal translation initiation."[4]

Since the Examiner has pointed to nothing concerning the functionality of the third epitope marker in the analysis of these references, it is clear that there is no justification for the Examiner's combination. The Examiner has created something which none of the references need. For the reasons provided above, the Applicants respectfully contend that the rejection of Claims 1, 9 and 11-12 should be withdrawn.

II. Claims 1, 9 and 11-13 are not unpatentable under 35 U.S.C. §103(a).

Based on the above arguments regarding the references Little et al., Garvin et al. and Knop et al., the Applicants likewise contend that the rejection of Claims 1, 9 and 11-13 should be withdrawn.

[3] Office Action, page 7, line 12.
[4] Office Action, page 6, lines 9-14.

CONCLUSION

The Applicants contend that Claims 1, 9 and 11-13 are in condition for allowance. Should the Examiner believe a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned at 781.828.9870

Respectfully submitted,

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